IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Asgeir Sæbo *et al.*		
Serial No.:	09/544,084	Group No.:	1617
Filed:	04/06/00	Examiner:	Wang, S.
Entitled:	**CONJUGATED LINOLEIC ACID COMPOSITIONS**		

APPELLANTS' REPLY BRIEF

APPEAL NO.:

EFS WEB FILING
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Brief is in reply to the Examiner's Answer mailed October 5, 2007.

It is not believed that any fees are necessary for this reply. However, if any fees are necessary, the Examiner is hereby authorized to charge Deposit Account No. 504302 the fee associated with this Reply Brief and any other fees associated with this communication. Please reference Attorney Docket No.: CONLINCO-04286 when charging the Attorney Deposit Account.

ARGUMENT

The Office's acceptance of the statements of the real party in interest, status of claims, status of amendments after final, summary of invention, and issues, and grouping of the claims is appreciated.

Below, Appellants specifically address the following issues from the initial Appeal Brief:

Issue 1 – Whether Claims 1-18 and 31 are obvious under the judicially created doctrine of obviousness-type double patenting over claims 9-16 of U.S. Patent No. 6,015,833 (hereinafterin, "the Sæbo patent") in view of U.S. Patent No. 5,760,082 (hereinafter, "the Cook patent"); and

Issue 2 – Whether Claims 1-18 and 31 are obvious over the Cook patent in view of WO97/18320 (hereinafter, "the Cain patent") and U.S. 3,162,658 (hereinafter, "the Baltes patent") in further view of U.S. 5,885,594 (hereinafter, "the Nilsen patent").

Issue 1 - Claims 1-18 and 31 Are Not Obvious Under The Judicially Created Doctrine Of Obviousness-Type Double Patenting.

Claims 1-18 and 31 are rejected under the judicially created doctrine of obviousness-type double patenting over claims 9-16 of the Sæbo patent in view of the Cook patent. The Examiner asserts that the Sæbo patent claims a food product containing conjugated linoleic acid, and that the Cook patent teaches that the derivative of conjugated linoleic acid, including esters, are similarly useful as the free acid in food products (1st Office Action, page 3).

In the Appeal Brief, the Applicant argued that the doctrine of obviousness-type double patenting requires that there be a common relationship of **inventorship** and/or **ownership** of two or more patents or applications (see MPEP §804). Moreover, since the doctrine seeks to avoid

unjustly extending patent rights at the expense of the public, the focus of any double patenting analysis is necessarily on the **claims** in the multiple patents or patent applications involved in the analysis (see MPEP §804). Since the Cook patent does not have either inventorship or ownership in common with the present application, this doctrine cannot apply. Moreover, the Examiner combined the **disclosure** in the Cook patent with the **claims** of the Sæbo patent, which is an incorrect analysis under the doctrine. Therefore, the Applicants the rejection of the claims on this basis should be withdrawn.

The Applicant's arguments regarding this issue were **uncontested** in the Examiner's Answer. Indeed, this issue is not addressed in the Examiner's Answer.

Issue 2 - Claims 1-18 And 31 Are Not Obvious Over The Combination Of The Cook, Baltes And Nilsen Patents.

Claims 1-18 and 31 stand rejected under 35 U.S.C. §103(a) as allegedly being obvious over the combination of the Cook, Baltes, and Nilsen patents. The Office has failed to establish a *prima facie* case of obviousness because 1) the Office has not provided a motivation to combine the references; 2) the Office is applying hindsight reconstruction; 3) the Office is improperly disregarding the Sæbo Declaration; and 4) the Office is misapplying the law.

1. The Office Has Ignored Evidence Presented By The Applicants That Establishes That Patentable Weight Should Be Given To The Combination Of Adding Alcoholate Catalyzed CLA To Food Products.

Applicants **have provided evidence** as to why a method that uses CLA produced by alcoholate catalysis to make food products is non-obvious. The Office, however, has ignored the evidence presented by the Applicants establishing that patentable weight should be given to the

combination of adding alcoholate catalyzed CLA to food products. In particular, in reference to the patentability of the claims, the Office stated:

> [R]egarding the limitation about the method to obtain the conjugated linoleic acid, note a method of making ingredients is not seen to render patentable weight to a method which employs such ingredients, absent evidence to the contrary." Office Action dated July 16, 2003; Paper Number 20030716; page 4.

Applicants first note that this statement ignores the actual language of the claims, which specify the particular step of using an alcoholate catalyst. This is contrary to the Office's statement that the claims only employ such ingredients. **Applicants fail to see how the Office can simply ignore a process step and reason that a specific step cannot provide patentable weight to a method claim.** The Office provided no legal authority on this point. Applicants are not aware of any such legal precedent.

Furthermore, Applicants **have provided** evidence that it is not obvious to simply use a process that was previously used for the production of CLA for industrial uses with a method for food production. This evidence is provided by the Declaration of Asgeir Sæbo (provided with the filed Appeal Brief). As detailed in the Sæbo Declaration, none of the references teach or suggest using CLA isomerized with alcoholate catalysts in food products. Furthermore, as explained by Dr. Sæbo, the Baltes patent discloses the use of oils with high levels of triunsaturated fatty acids. These oils are not generally suitable for the production CLA for oral consumption. **Thus, the Office's attempt to claim that the compositions of Baltes could be used in a food product is misguided.**

In fact, the Baltes reference indicates that the uses the products are suited for are industrial in nature. In particular, Baltes et al. describe methods for producing conjugated linoleic acids described as being "valuable industrial products" for use in formation of "light

colored polymers," for use as "ingredients of lacquers or coating compositions" or as "ingredients of plasticizers" and as "reaction components in the preparation of resins" (Baltes et al., *col.* 9, *ll.* 47-60). As such, the Baltes reference is directed to the production of substitutes for tung oil that are not suitable for consumption. The tung oil substitutes described in Baltes et al., are intended for industrial uses such as for drying oils, varnishes, and lacquers. Consequently, Baltes et al., describes methods for producing toxic oil substitutes for non toxic oils (tung oil). Nothing in the Baltes et al. reference teaches or suggest the desirability--or even applicability--of using the methods disclosed therein to produce food products.

Thus, Applicants **have provided evidence** as to why a method that uses CLA produced by alcoholate catalysis to make food products is non-obvious. The Examiner must respond to all of the arguments and evidence presented by Applicants.[1]

Indeed, the Federal Circuit recently reiterated that when a patent applicant puts forth rebuttal evidence within the context of a prima face case of obviousness, the Patent and Trademark Office (PTO) and the Board of Patent Appeals and Interferences must consider that evidence. *In re Sullivan*, 498 F.3d 1345 (Fed. Cir. 2007) (declarations describing claimed composition were relevant, and thus had to be considered by Patent and Trademark Office (PTO) Board of Patent Appeals and Interferences on applicant's proffer of rebuttal evidence in response to prima facie case of obviousness in application for patent). Moreover, the failure to rebut either the arguments or the evidence advanced by the Applicants is reversible error under *In re Alton*, 76 F.3d 1168, 37 U.S.P.Q.2d 1578 (Fed. Cir. 1996).

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[1] MPEP §§2144.08; *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986).

In re Alton is directly applicable to the present facts. Instead of addressing the arguments presented in the Sæbo Declaration, the Office has provided only conclusory statements and failed to address the particular evidence offered in the Declaration. In particular, the Sæbo Declaration provides evidence that:

- "The Baltes patent is not applicable to the present invention because the Baltes patent teaches methods of making CLA and conjugated linolenic acid (CLnA) for technical purposes such as drying oils and paint varnishes.
- The intended use of the conjugated linoleic acids for technical purposes as opposed to nutritional purposes is further reaffirmed at Column 9, lines 47-60 of Baltes patent where it is stated that "[t]he compounds of conjugated fatty acids obtained by the method of this invention, or mixtures containing these compounds, are valuable industrial products which can be used in may ways. . . . The polymers thus formed can be used as ingredients of lacquers or coating compositions in conventional manners."
- Based on the disclosure of the Baltes, Cook and Lievense patents, one cannot conclude that the CLA resulting from the alcoholate catalysis process is suitable for use in products meant for oral consumption.
- Other disclosure in the Baltes patent also indicates the insuitabity of the methods for the production of edible CLA.
- The Baltes patent describes the conjugation of soybean oil (Examples 1, 2, 6, 8, 9, 10, and 11), cottonseed oil (Example 3), linseed oil (Examples 4 and 5), and fish oil (Example 7), all of which contain high levels of triunstaurated fatty acids. These oils are generally unsuitable for obtaining CLA for nutritional uses because the refinement results in products with substantial amounts of breakdown products and unwanted polymers, especially when conjugated.
- However, it is noted that the use of oils with high levels of triunsaturated fatty acids as starting materials for CLA and CLnA for technical purposes is preferred due to the superior drying properties of conjugated trienes.

The only rebuttal of this evidence is provided in the Office Action dated December 28, 2001. The Examiner's attempted rebuttal, in its entirety, is as follows:

> The declaration filed October 18, 2001 [the Sæbo Declaration] is insufficient to overcome the rejection of claims 1-30 set forth above

> because: the teaching of Baltes et al. is not limited to the particular oil disclosed in the examples therein. Baltes teaches a general method for isomerising unconjugated polyethenoid to conjugated polyethenoid. See, column 1, lines 13-16. The starting material may be any unconjugated polyethenoid compounds or products containing them. See column 8, lines 20-68. Further, applicant appears to argue the employment of the reaction mixture to foodstuff, what is actually in the claims are the compounds, i.e., conjugated linoleic esters. ("to provide conjugated linoleic acid esters", see the claims in the instant application). Office Action dated December 21, 2001; Paper Number 12; page 5.

In the Examiner's Answer, the Examiner provided the same argument (verbatim) as provided in the December 28, 2001 Office Action.

This response completely fails to respond to any of the points listed above. The Office states that Baltes is not limited to any particular oil. However, this fails to respond to the conclusion advanced by Mr. Sæbo that one skilled in the art would read the application to be directed to oils with high levels of triunsaturated fatty acids because a substitute for Tung oil was being sought. The Office further states that Baltes teaches the use of the resulting polyethenoid compounds for "any" product. However, this statement ignores the evidence advanced that a person of ordinary skill in the art would read Baltes as being directed to use of CLA for technical purposes, such as in paints in varnishes. Finally, the Office, states that "applicant appears to argue the employment of the reaction mixture to foodstuff" and dismisses the argument the claims are allegedly (and mistakenly) to compounds. This is precisely the point and indeed, what is claimed! **The use of the method of Baltes to produce CLA for use in foodstuffs is not obvious. As discussed above, the Examiner has failed to examine the invention as a whole.**

As a result, Applicants respectfully request that the Examiner reconsider the evidence offered in the Sæbo Declaration. This evidence establishes that cited references cannot be properly combined and thus rebuts a prima facie case of obviousness. Accordingly, Applicants respectfully request that the claims be passed to allowance.

2. There Is No Motivation To Combine The References In The Manner Indicated By The Office

The Office fails to provide suitable evidence of a motivation to combine the Cook, Baltes, and Nilsen patents, thus a *prima facie* case of obviousness has not been established. The Office has made the following statements:

> The "well-known" conclusion is supported by the teaching of Baltes et al. Cain et al. The instant claims are drawn to a method of making CLA and using CLA in food product. If the method of making CLA herein claimed is well-known, and using CLA in food product is well-known, the claimed method would have been obvious. Office Action dated February 11, 2004; Paper Number 20040206Feb2004 OA pages 5-6.

> In the instant situation, the prior art teaches the employment of CLA as food ingredient was known, and using alcoholic catalyst for making CLA was also known, the employment of CLA made by alcoholic catalyst for food would have been obvious to one of ordinary skill in the art. *There is no need of invoking high level of skill in the art.* Office Action dated August 25, 2004; Paper Number 20040819; pages 5; emphasis added.

> The employment of CLA made by alcoholic catalyst for food would have been obvious to one of ordinary skill in the art. *There is no need of invoking high level of skill in the art.* Examiner's Answer, page 6; emphasis added.

Applicants respectfully submit that these statements are **misapplications of the law**.

Applicants respectfully submit that in effect the Examiner is attempting to make an obvious to try type argument. The Office's basic argument is that **if** two things are well known (alcoholate catalysis and CLA in food), **then** the combination of the two things is well known (using CLA produced by alcoholate catalysis in food) (e.g., such a combination would be obvious to try). Indeed, the Office goes so far as to state that in such circumstances, "[t]here is no need of invoking high level of skill in the art." This reasoning is completely devoid of any motivation to combine. Indeed, the only reasoning provided is that the two things are "well

known." The Applicants respectfully submit that this type of argument is factually and legally unsupportable.

In light of recent Supreme Court and Federal Circuit decisions, a conclusion that the presently claimed invention is prima facie obvious because it is allegedly "obvious to try" is factually and legally unsupportable.

In *KSR Int'l Co. v. Teleflex Inc.,* 127 S. Ct. 1727 (2007), the Supreme Court specifically noted that, in some circumstances, "the fact that a combination was obvious to try ***might*** show that it was obvious under §103." (emphasis added). The Supreme Court's decision specifically referred to circumstances

> "When there is ***a design need or market pressure to solve a problem*** and there are *a* ***finite number of identified, predictable solutions***, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. ***In that instance the fact that a combination was obvious to try might show that it was obvious under §103***." (emphasis added).

Subsequently, and in view of the unanimous Supreme Court decision in KSR, the Federal Circuit reemphasized that

> "[w]hen there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp." KSR, 127 S. Ct. at 1732. In such circumstances, 'the fact that a combination was obvious to try might show that it was obvious under § 103.' Id."[2]

However, the Federal Circuit, following the guidance of the Supreme Court, distinguished the circumstances of KSR from those before it in Takeda Chemical.

In Takeda Chemical, the appellant, Alphapharma, argued in a Declaratory Judgment action that a claimed chemical compound was an obvious modification of a previously known

[2] See *Takeda Chemical Industries v. Alphapharm, No. 06-1329, slip op. (Fed. Cir. June 28, 2007)*, at 15.

compound, the modification requiring the substitution of a homolog in a different ring position.[3] Specifically, and in an attempt to seize upon the Supreme Court's acknowledgment that a combination of elements that are obvious to try might support obviousness under § 103, Alphapharma argued to the Federal Circuit that the claimed compounds would have been obvious because the prior art compound fell within "the object reach of the claim," and the evidence demonstrated that using the techniques of homologation and ring-walking would have been "obvious to try."

The Federal Circuit rejected Alphapharm's arguments and held that in view of KSR, in circumstances in which the prior art disclosed a broad selection of compounds any one of which could have been selected as a lead compound for further investigation, the prior art does not provide a predictable solution…Thus, this case fails to present the type of situation contemplated by the [Supreme] Court when it stated that an invention may be deemed obvious if it was "obvious to try." The evidence showed that it was not obvious to try."[4]

Applicants have pointed out that the Baltes patent is directed to the production of substitutes for tung oil that are not suitable for consumption. The tung oil substitutes described in the Baltes patent are intended for **industrial uses** such as for drying oils, varnishes, and lacquers. Consequently, Baltes et al., describes methods for producing toxic oil substitutes for non toxic oils (tung oil). Nothing in the Baltes et al. reference teaches or suggest the desirability--or even applicability--of using the methods disclosed therein to produce food products. Moreover, Applicants **have provided** evidence that it is not obvious to simply use a process that was previously used for the production of CLA for industrial uses with a method for food production (see, Declaration of Asgeir Sæbo (provided in the Evidence Appendix)). As detailed

[3] Id.
[4] Id.

in the Sæbo Declaration, the Baltes patent does not teach or suggest using CLA isomerized with alcoholate catalysts in food products. Furthermore, as explained by Dr. Sæbo, the Baltes patent discloses the use of oils with high levels of triunsaturated fatty acids. These oils are not generally suitable for the production CLA for oral consumption.

Thus, an argument that the cited references render the claimed invention prima facie obvious because it might appear obvious to try (e.g., obvious to modify the industrial application described in the Baltes patent for use in producing food products) is not legally supportable. The cited references **do not provide a predictable solution** for generating food products in light of the industrial uses described in the Baltes et al. reference, nor teach that such a modification would be possible or desirable. The Federal Circuit has expressly identified that this type of argument falls outside the scope of the situation contemplated by the Supreme Court in KSR when the Court stated that an invention may be deemed obvious if it was "obvious to try."

Moreover, the Federal Circuit has warned against obviousness rejections that ignore "the high level of skill in the art":

> The Board did not . . . explain what specific understanding or technological principal within the knowledge of one of ordinary skill in the art would have suggested the combination. **Instead, the Board merely invoked the high level of skill in the art.** If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technological advance. Instead, in complex scientific fields, the Board could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for rejection. To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness (Emphasis added).

In re Rouffet, 47 USPQ2d 1453 (Fed. Cir. 1998). In the instant application, the sole basis for combination is the allegedly "well-known" status of two separate concepts. The Examiner's combination on this basis is inadequate as a matter of law.

The Office has also failed to analyze the invention as a whole. When analyzed as a whole, the use of a method for making CLA is non-obvious when the CLA is going to be utilized for food. "That each element in a claimed invention is old or unpatentable does not determine the nonobviousness of the claimed invention as a whole." *Custom Accessories v. Jeffrey-Allan Industries Inc.,* 807 F.2d 955, 1 USPQ 2d 1196, 1198 (Fed. Cir. 1986); See also *Brantingson Fishing Equipment Co. v. Shimano American Corp.*, 9 USPQ 2d 1669, 1672 (Fed. Cir. 1988). Put another way: "Only God works from nothing. Men must work with old elements." *Fromson v. Advance Offset Plate, Inc.*, 755 F.2d 1549, 225 USPQ 26, 31 n. 3 (Fed. Cir. 1985) (quoting from Markey, "Why Not the Statute," 65 JPOS 331, 333-334 (1983)).

In the instant case there has been no showing of why one would be motivated to use the alcoholate catalysis process in the production of CLA for food uses as claimed. Absent a motivation to combine the references, the Office has not established a prima facie case of obviousness.

The Office contended that the *Custom Accessories*, *Brantingson Fishing Equipment Co.*, and *Fromson* cases are not relevant to the instant invention. In particular, the Office stated:

> [T]he cited cases, Fromson in particular, are not suitable for the instant situation. Particularly, In Fromson, each and every steps and the materials involved are closely related in terms of time and space, each step would affect the others. It would be impossible to separate the step and materials involved. In the instant situation, the two ingredients involved, CLA and food could be made separately in term of space and time. Method of making one ingredients would not affect the other. Office Action dated August 25, 2004; Paper Number 20040819; pages 6.

The Applicants contend that the Examiner is misunderstanding the holding of the *Fromson* case. In particular, the *Fromson* case holds that the unpatentability of a set of elements does not render the combination of the references obvious. As noted, in the instant case, there has been showing of why one would be motivated to use the alcoholate catalysis process in the

production of CLA for food uses as claimed. As such, the *Fromson* case is particularly relevant because the Office is attempting to do precisely what the *Fromson* court deemed unacceptable. Accordingly, the Office has not established a prima facie case of obviousness and that the claims should be passed to allowance.

The Office further contended:

> As to Baltes' teaching, the examiner restates that Baltes reference does not expressly limited to produce CLA for coating. Note question under 35 U.S.C. 103 is not merely what reference expressly teach, but what they would have suggested to one of ordinary skill in the art a the time the invention was made; all disclosures of prior art, including unpreferred embodiments, must considered. In re Lamberti and Konort (CCPA), 192 USPQ 278. Contrary to applicants' assertion, Baltes state "The invention relates to a process for substantially complete catalytic conversion of compounds of unconjugated polyethenoid acid into compounds of conjugated enthenoid acid." (column 1, lines 13-16). "It will be appreciated from the above that this invention is not limited to the materials, steps, conditions and other details specifically described above and can be carried out with various modification. Thus, it will be understood that the process of this invention is broadly applicable to any unconjugated polyehtenoid acid compounds and products containing them." (column 8, lines 20-50, examiner emphasis added). Baltes particularly claims the process for the catalytic isomerization of unconjugated polyethenoid fatty acid compounds to conjugated isomers using alkali metal monohydric alcoholate (see, particularly, claim 10-12). Office Action dated August 25, 2004; Paper Number 20040819; pages 4-6-7.

In the Examiner's Answer, the Examiner provided the same argument (verbatim) as provided in the August 25, 2004 Office Action.

The Office takes this statement completely out of context. As pointed out in the Declaration of Asgeir Sæbo, Baltes teaches the use of alcoholate catalysts to produce CLA for use in industrial products such as paints and varnishes. **Baltes fails to address the use of CLA made by these methods in food products.** Thus, a person of ordinary skill in the art reading Baltes would interpret the statement quoted by the Office as teaching that the processes of Baltes

could be used to produce CLA for use in industrial type products, not food products. As such, this so-called "suggestion" from Baltes cannot serve as motivation to combine the references.

3. The Office's Reasoning Demonstrates Hindsight Reconstruction

The Office has applied hindsight reconstruction to combine the Cook, Baltes, and Nilsen patents. As noted in the *In re Rouffet* case cited above, hindsight reconstruction is not permitted. The Office, however, relies upon *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971) for the proposition that:

> [I]t must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

To the extent that this 1971 C.C.P.A. case appears to condone hindsight reconstruction when providing a motivation to combine references, the Federal Circuit has *sub silentio* overruled this proposition, and has emphatically stated that hindsight reconstruction is not proper.[5] Accordingly, to the extent the Office has admitted reliance on hindsight reconstruction, that reliance is misplaced as a matter of law.

[5] See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988) ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention"); *Gillette Co. v. S.C. Johnson & Son, Inc.*, 919 F.2d 720 (Fed. Cir. 1990) (The inappropriateness of hindsight as a test of obviousness was, in point of fact, discovered, and articulated lucidly, over three centuries ago, by Milton, who, in Paradise Lost Part IV, L. 478-501, stated "The invention all admired, and each how he To be the inventor missed; so easy it seemed, Once found, which yet unfound would have thought, Impossible!"); *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.*, 21 F.3d 1068 (Fed. Cir. 1993) ("The motivation to combine references can not come from the invention itself"); *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566 (Fed. Cir. 1996) ("To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction-an illogical and inappropriate process by which to determine patentability"); *W.L. Gore & Assocs., Inc. v. Garlock Inc.*, 721 F.2d 1540 (Fed. Cir. 1983) ("To imbue one of ordinary skill in the art with the knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of hindsight syndrome wherein that which only the inventor taught is used against its teacher ...").

The Applicant's arguments regarding this issue were **uncontested** in the Examiner's Answer. Indeed, this issue in the Examiner's Answer.

4. The Examiner's Citation Of *In re Boesch* Is Inappropriate

The Examiner has cited *In re Boesch*, 205 USPD 215 (CCPA 1980) for the proposition that:

> Further, purifying CLA composition by using silica gel (adsorbent) is seen to be obvious since silica gel is well known for purification and separation purpose. Having a limitation of the volatile organic compound (VOC) in food product (whether it the limitation after storage or before storage) is considered an optimization of a result effective parameter, which is considered within the skill of the artisan. Office Action dated August 25, 2004; Paper Number 20040819; pages 4-5.

In the Examiner's Answer, the Examiner further contended:

> Appellants' arguments that amounts volatile organic compounds (VOC) is not a result effective variable for food product have been fully considered, but are not persuasive. If VOC would affect the quality of food products, every effort would have been made to control the amount of VOC in food products. e.g., Cook teaches that any solvent in CLA should be removed under vacuum, before the CLA could be used in food product. Examiner's Answer, page 9.

The Examiner is respectfully directed to the MPEP at §2144.05 which states a "particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimization of workable ranges of said variable might be characterized as routine experimentation." The MPEP additionally cites *In re Antonie*, 559 F.2d 618 (CCPA 1997) for the proposition that the failure of the prior art to recognize a result-effective variable results in the nonobviousness of a claimed range. This is

contrasted with *In re Boesch*, in which the court held that the prior art suggested proportional balancing to achieve desired results in the formation of an alloy.

In the instant case, the amount of VOC is not a result effective variable, it is a property which results from the proper treatment and handling of the CLA. It is noted, however, the underlying methods of treatment may involve result effective parameters, for example, silica adsorption with particular amounts of silica for the removal of metal ion contaminants. The claims are not limited to the methods and thus the result-effective variable analysis is inactive. Applicants further note that this treatment step is not recognized by the prior art as a treatment method for CLA products and thus, if it were claimed, would actually establish the patentability of the claims.

CONCLUSION

For the foregoing reasons, it is submitted that the Office's rejection of Claims 1-18 and 31 was erroneous, and reversal of the rejection is respectfully requested. Appellant requests either that the Board render a decision as to the allowability of the claims, or alternatively, that the application be remanded for reconsideration by the Office.

Dated: December 5, 2007

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